

SCHERING-PLOUGH CORPORATION
LAW DEPARTMENT
2000 GALLOPING HILL ROAD
K-6-1, MAIL STOP 1990
KENILWORTH, NEW JERSEY 07033
(908) 298-4000

RECEIVED
CENTRAL FAX CENTER
MAY 30 2006

FACSIMILE TRANSMITTAL SHEET

TO: Examiner: Z. N. Davis
USPTO

FAX NUMBER:
(571) 273-8300

FROM: Palaiyur S. Kalyanaraman

PHONE NUMBER:
(908) 298-5068

TOTAL NO. OF PAGES INCLUDING COVER
6

DATE
May 30, 2006

CONFIDENTIALITY NOTE: This sheet and/or the document(s) accompanying it contain information belonging to Schering-Plough Corporation and/or its affiliates which is confidential and/or legally privileged. The information is intended only for the use of the individual or entity named above. If you have received this fax in error, please immediately notify us by telephone. If there is a problem with this transmission please call Ashly Armstrong at (908) 298-4025.

NOTES/COMMENTS:


PLEASE HAND DELIVER

In re Application of: B. Shankar *et al.*
For Patent entitled: "Cannabinoid Receptor Ligands"
Group Art Unit: 1625
Filed: 03/18/2004
Attorney Docket No.: IN06009US01
Serial No.: 10/803,577

Dear Examiner Davis

Transmitted herewith are:

- Fax Cover Sheet – 1pg.
- Cert. of Transmission – 1pg.
- Response Transmittal – 1pg.
- Response to Restriction Requirement – 3pgs.


Palaiyur S. Kalyanaraman
Registered Representative
Registration No. 34,634

PHONE: (908) 298-5068

FAX: (908) 298-5388

RECEIVED
CENTRAL FAX CENTER

MAY 30 2006

Docket Number: IN06009US01

Application No: 10/803,577

Filing Date: 03/18/2004

First Inventor: SHANKAR, Bandarpalle B.

PTO/SB/97 (08-04)

Approved for use through 07/31/2006. OMB 0851-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office at (571) 273-8300

on May 30, 2006
Date

Signature

PALAIYUR S. KALYANARAMAN

Typed or printed name of person signing Certificate

34,634

Registration Number, if applicable

908-298-5068

Telephone Number

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

- Fax Cover Sheet – 1pg.
- Cert. of Transmission – 1pg.
- Response Transmittal – 1pg.
- Response to Restriction Requirement – 3pgs.

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER
MAY 30 2006

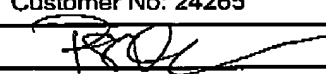
Express Mail Label:

PTO/SB/21 (09-04)

Approved for use through 07/31/2006. OMB 0651-0031
 U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	10/803,577	
	Filing Date	03/18/2004	
	First Named Inventor	SHANKAR, Bandarpalle B.	
	Art Unit	1625	
	Examiner Name	Z. N. Davis	
Total Number of Pages In This Submission	6	Attorney Docket Number	IN06009US01

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Fax Cover Sheet - 1pg. ; Cert. of Transmission - 1pg.
Remarks _____		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Customer No: 24265	
Signature		
Printed name	PALAIYUR S. KALYANARAMAN	
Date	May 30, 2006	Reg. No. 34,634

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
Signature		
Typed or printed name		Date

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PATENT CASE: IN06009US01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

B. Shankar et al

Application No.: 10/803,577

Filed: 03/18/2004

For: **"Cannabinoid Receptor Ligands"**

Examiner: Z. N. Davis

Group Art Unit: 1625

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This communication is in response to the Office Action issued on May 4, 2006 in the subject case. This communication is being faxed to the Examiner's attention at 571-273-8300.

Claims 1-57 are pending in the case. The Examiner restricted the invention into seven groups:

Group I: Claims 1-23, 30 and 31, drawn to a compound, a pharmaceutical composition and process to make the compound, according to formula I;

Group II: Claims 24-29, drawn to a method of treating diseases using a compound of formula I;

Group III: Claims 32-39 drawn to a pharmaceutical composition and method of treating rheumatoid arthritis using a compound of formula I;

Group IV: Claims 40-43, drawn to a pharmaceutical composition and a method for treating multiple sclerosis using a compound of formula I;

Group V: Claims 44-51, drawn to a pharmaceutical composition and a method for treating rheumatoid arthritis using a compound of formula I;

Group VI: Claims 52-57, drawn to a pharmaceutical composition and method of treating seasonal allergic rhinitis using a compound of formula I; and

Group VII: Claims 52-57, drawn to a pharmaceutical composition and method of treating asthma using a compound of formula I;

If electing a compound group from among Groups I-VII, the Examiner additionally required the election of a single disclosed species for prosecution on the merits.

Applicants believe that all claims 1-57 form part of one and the same invention. Applicants further believe that when there is a linking claim (claim 1 here) encompassing the scope of all the processes, uses, composition and compounds, it is inappropriate to restrict the invention into these various inventions. Applicants also believe that due to such commonality, a complete examination of claims 1-57 as filed would not cause undue burden. Applicants further believe that the same art search will most probably apply to the alleged separate inventions, and respectfully submit that the restriction is improper.

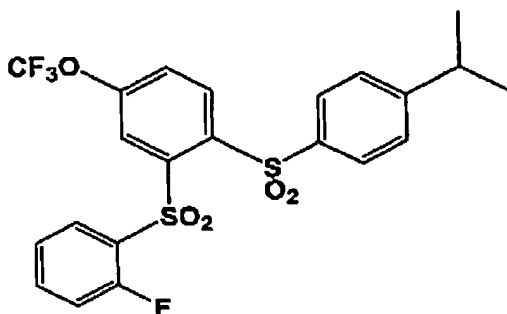
Under the statute "two or more independent and distinct inventions.... in one application may.... be restricted to one of the inventions." Inventions are "independent" if "there is no disclosed relationship between two or more subjects disclosed" (MPEP 802.01). The term "distinct" means that "two or more subjects as disclosed are related.... but are capable of separate manufacture, use or sale as claimed, and are patentable over each other" (MPEP 802.01). However, even when patentably distinct inventions, restriction is not required unless one of the following reasons appear (MPEP 808.02):

1. Separate classification
2. Separate status in the art; or
3. Different field of search.

In the present application, Applicant believes that the Examiner has not established a clear reason to establish the existence of any of the above 3 groups. Reconsideration and withdrawal of the restriction requirement are, therefore, respectfully requested.

However, in the interest of advancing the prosecution, Applicants elect, with traverse, the invention cited as Group I for prosecution on the merits, and elect, again with traverse, the following species:

3



This compound is included in Claim 17 and is also identified in the scheme on page 43 as Compound 12C. All claims of the elected group read on this compound.

Applicants note with appreciation that the Examiner has indicated rejoinder of process claims that depend from or otherwise include all the limitations of the patentable product as a matter of right.

If the Examiner has questions, the Examiner is invited to contact the undersigned.

May 30, 2006
Schering-Plough Corporation
2000 Galloping Hill Road
Patent Department, K-6-1, 1990
Kenilworth, NJ 07033
Tel: (908) 298-5068
Fax: (908) 298-5388

Respectfully submitted,

Dr. Palaiyur S. Kalyanaraman
Attorney for Applicants
Reg. No. 34,634